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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/928,272 09/12/97 ISKRA

M P-3818

EXAMINER

QM12/1004

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CHO, D	
ART UNIT	PAPER NUMBER

3761

DATE MAILED:

10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/928,272

Applicant(s)

Iskra

Examiner

David J. Cho

Group Art Unit
3761



☒ Responsive to communication(s) filed on Sep 14, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 5-9 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 5-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns '5,458,854.

Burns teaches a collection assembly useful for collecting small quantities of blood, wherein the closed bottom end 38 represents a partition member, see figure 1. In regards to the partition member, the closed bottom end 38 clearly is integral with the housing sidewall 22. With respect to claim 7 and 8, see column 5, lines 43-49. With respect to claim 9, it is observed that applicant's specification does not disclose that the dimensions solves any particular problem or produces any unexpected result and therefore such is merely a matter of engineering design choice, and thus does not serve to patentably distinguish over the prior art. However, Burns does not disclose the false bottom end comprising an open bottom end extending from an arcuate shoulder. It would have been obvious matter of design choice to form the false bottom into an arcuate shape, since such a modification would have involved a mere change in the shape of the

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component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Response to Arguments

3. Applicant's arguments filed 9/14/00 have been fully considered but they are not persuasive.

In response to applicant's argument that Burns does not teach or suggest a false bottom container having a rounded open bottom end, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that the present invention is a one-piece collection container is found non-persuasive. In other words, the argument that Burns require additional

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structure is unpersuasive because it would still read on the claim limitation and found to be obvious to provide Burns with a rounded bottom end. Moreover, even for argument sake, if Burns does require the additional structure, Burns would still be compatible with standard clinical equipment by inserting the device of Burns through a standard test tube tray. However, because the examiner believes that Burns does read on the claimed invention, e.g., one-piece collection container, it is found non-persuasive.

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David J. Cho, whose telephone number is (703) 308-0073. The Examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

david j. cho



Patent Examiner
September 27, 2000



David J. Cho
Senior Patent Examiner
703-308-0073